

12-30-2002

IN THE UNITED STATES PATENT  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

U.S. Patent & TMO/TM Mail Rpt Dt #7:

ICE

IN THE MATTER OF APPLICATION SERIAL NO. 76/003,578  
PUBLISHED IN THE OFFICIAL GAZETTE ON AUGUST 27, 2002

LUSTER PRODUCTS, INC.

Opposer,

v.

INTIMATE BEAUTY CORPORATION, DBA  
VICTORIA'S SECRET BEAUTY,

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

In the matter of the trademark application of INTIMATE BEAUTY CORPORATION, DBA VICTORIA'S SECRET BEAUTY, for the registration of the mark **SHOCKING PINK** for perfume and cologne items sold in applicant's specialty retail stores, catalogues or website, in International Class 3, **Application Serial No. 76/003,578** filed on March 20, 2000, published in the Official Gazette of August 27, 2002, page TM 181;

Opposer LUSTER PRODUCTS, INC., an Illinois corporation with a principal place of business at 1104 West 43rd Street, Chicago, Illinois 60609, believes it will be damaged by the registration of the mark shown in the application and hereby opposes same against all three classes covered by the application.

The grounds for the opposition are:

1. Continuously since long prior to March 20, 2000, the Applicant's filing date for its application, the Opposer has

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TRADE MARK AND  
SERVICE MARK  
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marketed, advertised and sold and continues to sell throughout the United States under the names and marks **PINK** and **PINK PROTECTION** for an extensive range of hair care and personal care products.

2. Opposer's products sold under the above names and trademarks **PINK** and **PINK PROTECTION** have been extensively promoted throughout the United States to the relevant trade and to the consuming public.

3. By reason of Opposer's aforesaid extensive promotion and sale of its products, Opposer's names and trademarks **PINK** and **PINK PROTECTION** have acquired great recognition and renown, and the relevant trade and public have come to recognize the names and trademarks **PINK** and **PINK PROTECTION** as signifying Opposer exclusively.

4. Opposer has duly registered in the United States Patent and Trademark Office and owns the following registrations:

<u>REGISTRATION NUMBER</u>	<u>TRADEMARK</u>
1,503,517	<b>PINK PROTECTION</b>
1,511,336	<b>PINK</b>
1,649,218	<b>PINK</b>
1,864,492	<b>PINK</b>

5. Each of the registrations referenced in paragraph No. 4 for the above marks are valid subsisting registrations in full force and effect. Furthermore, Registration No. 1,649,218 has achieved "**incontestable**" registration status thereby constituting

conclusive prima facie evidence of Opposer's exclusive right to use said mark in commerce.

6. Applicant's claimed trademark **SHOCKING PINK**, as proposed for use in connection with perfume and cologne items sold in applicant's specialty retail stores, catalogues or website, in International Class 3, is so similar to Opposer's names and trademarks **PINK** and **PINK PROTECTION** used for a wide range of hair care and personal care products, as to be likely to create confusion, mistake or deception, all to the damage of Opposer, and to the damage of Opposer's rights in its names and trademarks, which names and marks have been in use long prior to the filing of the Applicant's trademark application.

7. That it is not unusual for consumers or prospective purchasers to expect that a mark used on hair care products would also be used on other personal care products, such as perfume or cologne. Furthermore, it would not be unusual for prospective purchasers to consider that companies selling perfume or cologne would also sell other types of personal care products, such as hair care products. In fact, the Applicant, based upon information and behalf, sells perfume, cologne and hair care products, at times, even using the same mark on all these items.

8. Opposer also markets hair care products under a variety of marks which include the word mark **PINK**. One of the Opposer's hair care products uses the virtually identical mark **PINK HOT OIL TREATMENT** to the mark **SHOCKING PINK** sought to be registered by the Applicant. Said mark has been in use by Opposer well prior to the Applicant's filing date for this application under opposition and the Applicant's earliest

priority date in the mark. The use of the virtually identical marks at issue gives rise to a likelihood of confusion, mistake or deception between the marks at issue.

9. Based upon information and belief the goods identified in the Applicant's application for the trademark **SHOCKING PINK** and those products sold under the Opposer's names and marks could be sold to the same potential consumers or end-users as the Opposer's products.

10. Opposer holds rights in a family of trademarks which include the name and mark **PINK** as a name and mark, or as part of an overall name and mark with said marks often promoted together. The Applicant's mark **SHOCKING PINK** is thereby confusingly similar to the Opposer's rights in its family of marks.

11. The Applicant filed the underlying application, on information and belief, with actual knowledge of the Opposer's name and mark **PINK** and after receiving written cautionary communications from representatives of the Opposer.

12. Use by the Applicant of the trademark **SHOCKING PINK**, for which registration is sought in the application opposed herein, is without Opposer's consent or permission.

13. Applicant's registration of the trademark **SHOCKING PINK** will result in damage and in the diminishment in sales and the loss of the value of the Opposer's names and marks.

14. Applicant, based upon information and belief, has not used the mark **SHOCKING PINK**. Applicant's earliest available possible priority date for the mark **SHOCKING PINK** is the filing date for its application, specifically March 20, 2000.

15. Applicant's registration of the trademark **SHOCKING PINK** will result in damage, dilution, and in the diminishment in sales and the loss of the value of the Opposer's famous names and marks.


WHEREFORE, Opposer believes it will be damaged by the registration of the claimed trademark in Application Serial No. 76/003,578 in International Class 3 and prays that this Opposition be sustained and that the Applicant's registration be denied.

This Notice of Opposition is being filed in duplicate and the required fee is enclosed. Please charge any additional costs to our Deposit Account No. 05-0630.

Please address all correspondence to Burton S. Ehrlich, Arnstin & Lehr, 120 S. Riverside Plaza, Suite 1200, Chicago, IL 60606, telephone (312) 876-7190.

Respectfully submitted,

By:

  
One of Opposer's attorneys

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited (in duplicate) with the United States Postal Service as First Class Mail addressed to BOX TTAB-FEE, Assistant Commissioner for Trademarks, U.S. Trademark Office, 2900 Crystal Drive, Arlington, VA 22202-3513 on December 24, 2002.

  
Burton S. Ehrlich